

but would be allowable if rewritten in dependent form including all of the limitations of the base claim and any intervening claims.

By this amendment, the subject matter of dependent claim 30 is being included in independent claim 29, and claim 29 is also being amended to more particularly point out and distinctly claim the subject matter sought to be patented and to further distinguish the claims over the cited reference. As a result, dependent claim 30 is being canceled. Claim 40 is being amended to more particularly point out and distinctly claim the subject matter sought to be patented. In particular, the characterizing language of the prosthesis assembly and introducer sheath previously recited in the preamble are being deleted therefrom and are being included in the main body of the claim. In view of the above, applicant submits that independent claims 29 and 40, as amended herein, particularly point out and distinctly claim the subject matter sought to be patented, and it is requested that the rejection of these claims under 35 U.S.C. § 112, second paragraph, be withdrawn.

Applicant has previously characterized the Choudhury reference. As previously discussed, expansion rings 32 of the Choudhury reference are not self-expanding spring assemblies, but are moved apart by expansion lead wires 44 to form single rings of larger diameter. Although expansion rings 32 may have some resiliency, the Choudhury reference clearly indicates that expansion lead wires 44 are manually pushed to cause convoluted expansion rings 32 to move apart. The Choudhury reference also does not disclose, teach, or even suggest a transluminal arrangement with an introducer sheath having a longitudinal bore therein. The prosthesis assembly including the self-expanding spring assembly is maintained in a compressed state when positioned in the bore of an introducer sheath. In view of the above, applicant submits that the transluminal arrangement of independent claim 29, as amended herein, is not identically disclosed, taught, or even suggested by the Choudhury reference, and it is requested that the rejection of this claim under

35 U.S.C. § 102(b) as being anticipated by the Choudhury reference be withdrawn.

Enclosed herewith is a "Declaration of Prior Invention in the United States to Overcome Cited Patent or Publication (37 CFR 1.131)" along with a supporting statement by the inventor to overcome the rejection of claims 24, 26-28, 31-35, 37, 39, and 40 under 35 U.S.C. § 102(a) as being anticipated by the Inoue (WO 91/12047) reference. This application is a continuation of parent application Serial No. 07/782,696, filed October 25, 1991. The declaration and supporting statement along with reproductions of applicant's laboratory notebook indicate that the applicant had conceived and reduced to practice his transluminal invention prior to the effective date of the Inoue reference, August 22, 1991. Applicant (Dr. Chuter) had also utilized his invention in transluminal surgical procedures on at least two dogs prior to the August 22, 1991, date. In view of the above, applicant submits that the Inoue reference is not effective as a prior art reference and that the rejection of claim 40, as amended herein, and claims 24, 26-28, 31-35 and 39 has been overcome. It is thus requested that the rejection of these claims under 35 U.S.C. § 102(a) as being anticipated by the Inoue reference be withdrawn. Applicant further submits that the rejection of dependent claim 37 under 35 U.S.C. § 103 as being unpatentable over the Inoue reference in view of the Choudhury reference has also been overcome, and it is requested that the rejection of this claim under 35 U.S.C. § 103, be withdrawn. It is further requested that the objection to claims 36 and 38, which are dependent on the aforementioned claims, also be withdrawn.

Dependent claim 5 is still pending in the application and is dependent on allowed independent claim 1. As a result, applicant submits that dependent claim 5 is allowable, and it is requested that the Examiner so indicate.

The reexamination and reconsideration of this application is respectfully requested, and it is further requested that the application be passed to issue.

Although the foregoing discussion is believed to be dispositive of the issues in this case, applicant's attorney

requests a telephone interview with the Examiner to further discuss any unresolved issues remaining after the Examiner's consideration of this amendment.

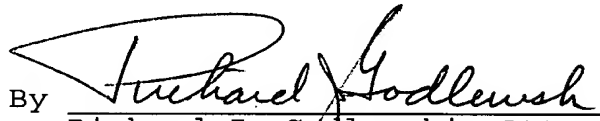
Respectfully submitted,

Timothy A. Chuter

Date:

Dec. 14, 1994

By


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Enclosures:

Petition and Fee for 1-month Extension of Time, in triplicate
Declaration of Prior Invention in the U.S. to Overcome Cited
Patent or Publication (37 CFR 1.131)
Supporting Statement by Inventor
Copies of bound laboratory notebook pages 7-15